

JAN 18 2005

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January 18, 2005

To: U.S. Patent and Trademark Office
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 Examiner Andrew D. Wright, Group Art Unit 3617
Fax No. 703-872-9306

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Docket No. 58584.US/1458.7

Date: JANUARY 18, 2005

Application No. 10/699,595

Filing Date: 10-31-2003

Applicant(s): Howard M. Thompson

Title: CORROSION RESISTANT PRESTRESSED CONCRETE FLOAT SYSTEM

Enclosures:

APPELLANT'S BRIEF ON APPEAL including a Certificate of Facsimile Transmission and authorization to charge our deposit account (8 pages submitted in triplicate)

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JAN 18 2005

Application No.10/699,595
Docket No. 58584.US/1458.7IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: THOMPSON, Howard M.
Serial No.: 10/699,595
Filed: 10/31/2003
For: CORROSION RESISTANT PRESTRESSED CONCRETE FLOAT SYSTEM
Examiner: WRIGHT, Andrew D.
Group Art Unit: 3617
Confirmation No. 1884

APPELLANT'S' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is filed in triplicate following the Notice of Appeal mailed on December 13, 2004. Please charge the \$250.00 filing fee to our Deposit Account No. 12-2355.

In the event this brief is not timely filed, Applicant hereby petitions for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12-2355**.

REAL PARTY IN INTEREST

The real party in interest is the Applicant, Howard M. Thompson, 984 Country Club Lane, Jackson, Tennessee 38305.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

Application No.10/699,595
Docket No. 58584.US/1458.7

STATUS OF CLAIMS

Claims 1-8 as originally filed are pending and appealed. Claims 1, 4, and 6 are independent claims. The claims stand rejected as follows:

Claims	Rejection
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SUMMARY OF THE INVENTION

The invention set forth in the specification provides corrosion resistant prestressed float units (See, Fig. 1). The invention also provides structures such as float systems and dock system utilizing the float units (See, e.g., Figs. 3, 5A, and 5B).

The float units include:

- a buoyant core encased within a polymeric coating. (Specification at page 3, line 12 - page 4, line 5).
- concrete encasing the core and polymeric coating. (Specification at page 4, lines 11-12).
- a corrosion resistant mesh to reinforce the concrete. (Specification at page 4, lines 12-17).
- a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit. (Specification at page 4, line 18 - page 5, line 2).

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ISSUES

1. Would the subject matter of Claims 1-8 have been obvious to the person of ordinary skill at the time of the invention?

GROUPING OF CLAIMS

For each contested ground of rejection and which applies to a group of two or more claims, the Board is requested to select a single claim from the group and to decide the appeal as to the ground of rejection on the basis of that claim alone.

ARGUMENT

In the Final Office Action, Claims 1-8 were rejected as being obvious over various combinations of references. The rejections are unsustainable and should be withdrawn.

Under 35 U.S.C. 103(a), the Examiner carries the initial burden of establishing a *prima facie* case of obviousness. In re Pianski, 745 F2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). As part of this, the Examiner must determine whether the differences between the subject matter of the claims and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art."

The rejection must rest on a factual basis with those facts being interpreted without hindsight reconstruction of the invention from the prior art. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The Federal Circuit has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated and disconnected teachings of the prior art. See, Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When, as in this case, the Examiner has selected elements of various teachings in making the rejection, the Board ascertains whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case,

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in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. §§ 103, the decision maker must bring judgment to bear.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See, In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

With respect to the rejection of claims 1, 2, 4, 6-7, the Thomson reference is relied on by the Examiner for teaching the basic structure of a pretensioned concrete float unit featuring a foam core encased in concrete. The Gonzalez reference is relied on by the Examiner for teaching protecting foam from water damage. The Shorter reference is relied on by the Examiner as "motivation" for modification of the Thomson structure to include a "protected" core.

The cited Gonzalez reference shows a floatation unit having a concrete channel slab that provides an upper portion of the unit, with a float unit foam float below the slab. The Gonzalez float unit is not of a construction having a foam float or other buoyant core encased in concrete. Rather, as noted at Col. 4, 49-53, the structure is designed to be open to ingress and egress of water.

The Examiner relies on the cited Shorter, Jr reference for teaching that it was known that "cracks may occur in concrete below the waterline." Based solely on this, the Examiner asserts that it would have been obvious to modify the device of Thomson to add the polyethylene coating of Gonzalez around the foam core of the Thomson device. However, as will be noted, Shorter does not attribute any negative to the development of cracks. Rather, Shorter describes that "use of the foam block permits the unit to float even though cracks develop in the concrete below the water line." In addition, the Examiner's reliance on the Shorter, Jr. reference does not establish that one of ordinary skill in the art would view the concrete encased foam structure of Thomson or Shorter, Jr. as requiring any correction or modification. The mere

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fact that the prior art may be modified to reflect features of the claimed invention does not make the modification obvious unless the desirability of such modification is suggested by the prior art. See, In re Fitch, 23 USPQ2d 1780 (Fed. Cir. 1992).

In an attempt to buttress his position, the Examiner asserts that the skilled artisan will recognize that cracks in the concrete will lead to exposure of the encased foam to water, and also that this can lead to exposure to acids and corrosives which can attack the foam. See, Final Office Action at page 4.

This reliance on "common knowledge" as to what a skilled artisan might recognize is improper, and the Examiner cannot simply reach conclusions based on his own assessment of what would be basic knowledge. Rather, the Examiner must point to concrete evidence in the record to support his findings. See, In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), In re Lee, 277 F.3d 1338-1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), and In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). In this case, the only suggestion for providing the claimed combination comes from the Appellant's own disclosure.

It is clear that there must be more than simply itemizing selected elements in the prior art and combining the elements to provide Appellant's invention. As the court stated in Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983), "... virtually all [inventions] are combinations of old elements." Identification of the elements in the prior art is not sufficient, however, to negate patentability, otherwise few patents would ever issue.

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 47 USPQ2d 1453, 1457, 1458 (Fed. Cir. 1998). The "... suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness." In re Rouffet, Ibid. at 1458.

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The rejection of claims 3, 5, and 8 is similarly flawed. In addition, the Examiner has again engaged in "common knowledge" evaluation of the invention. The Examiner relies on the fourth cited patent (Rytand) for disclosing the claimed vent structure. However, Rytand does not disclose any form of a vent for a float unit having a buoyant core encased in concrete with a vent extending into the core to vent gases from the core to the atmosphere. As stated by the Examiner, the Rytand core is "mostly encased" and the Examiner is relying on utility line chases of Rytand to inherently provide the venting structure. The bottom of Rytand is open and there is no need for venting structure. Accordingly, the Examiner has again pieced together components from the prior art using the Appellant's disclosure as a template.

In conclusion, it is submitted that the Examiner has engaged in impermissible hindsight reconstruction of the invention, by selectively choosing portions of the references and combining the portions of the references to provide the claimed invention without motivation from the references themselves to make the specific combination. It is therefore requested that the rejections of Claims 1-8 be reversed and the case passed to allowance.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

By:

— O. —

Robert O. Fox
Registration No. 34,165
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January 18, 2005
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Knoxville, TN 37901
Phone (865) 546-4305

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January 18, 2005
Date

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Robert O. Fox, Reg. No. 34,165

Application No.10/699,595
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APPENDIX

Claims on Appeal

Claim 1. A corrosion resistant prestressed float system, comprising one or more float units, each including a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

Claim 2. The float system of claim 1, further comprising a plurality of chaseways for receiving post tensioning members for interconnecting a plurality of the units in a desired manner.

Claim 3. The float system of claim 1, further comprising a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

Claim 4. A corrosion resistant prestressed float unit comprising a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

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Claim 5. The float unit of claim 4, further comprising a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

Claim 6. A floating dock system comprising a plurality of corrosion resistant prestressed float units, wherein the float units each comprise a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

Claim 7. The dock system of claim 6, further comprising a plurality of chaseways defined within each of the units and a plurality post tensioning members received within the chaseways for interconnecting a plurality of the units in a desired manner to provide the dock system

Claim 8. The dock system of claim 6, wherein one or more of the units includes a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

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Claim 2. The float system of claim 1, further comprising a plurality of chaseways for receiving post tensioning members for interconnecting a plurality of the units in a desired manner.

Claim 3. The float system of claim 1, further comprising a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

Claim 4. A corrosion resistant prestressed float unit comprising a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

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Claim 5. The float unit of claim 4, further comprising a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

Claim 6. A floating dock system comprising a plurality of corrosion resistant prestressed float units, wherein the float units each comprise a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

Claim 7. The dock system of claim 6, further comprising a plurality of chaseways defined within each of the units and a plurality post tensioning members received within the chaseways for interconnecting a plurality of the units in a desired manner to provide the dock system

Claim 8. The dock system of claim 6, wherein one or more of the units includes a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

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Application No.10/699,595
Docket No. 58584.US/1458.7

STATUS OF CLAIMS

Claims 1-8 as originally filed are pending and appealed. Claims 1, 4, and 6 are independent claims. The claims stand rejected as follows:

Claims	Rejection
1, 2, 4, 6-7	35 U.S.C. 103(a) as unpatentable over Thomson (US 3,799,093) in view of Gonzalez (US 3,779,192) and Shorter, Jr. (3,967,569)
3, 5, 8	35 U.S.C. 103(a) as unpatentable over Thomson (US 3,799,093) in view of Gonzalez (US 3,779,192), Shorter, Jr. (3,967,569) and Rytand et al. (US 6,450,737)

STATUS OF AMENDMENTS

No amendments to the claims have been made and no response has been filed subsequent to the Final Office Action dated October 25, 2004. Applicant filed a "Response A" on August 23, 2004, in response to a first Office Action dated May 25, 2004. The Examiner stated in the Final Office Action dated October 25, 2004, that the arguments Appellants presented on 8/23/04 have been fully considered but are not persuasive.

SUMMARY OF THE INVENTION

The invention set forth in the specification provides corrosion resistant prestressed float units (See, Fig. 1). The invention also provides structures such as float systems and dock system utilizing the float units (See, e.g., Figs. 3, 5A, and 5B).

The float units include:

- a buoyant core encased within a polymeric coating. (Specification at page 3, line 12 - page 4, line 5).
- concrete encasing the core and polymeric coating. (Specification at page 4, lines 11-12).
- a corrosion resistant mesh to reinforce the concrete. (Specification at page 4, lines 12-17).
- a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit. (Specification at page 4, line 18 - page 5, line 2).

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ISSUES

1. Would the subject matter of Claims 1-8 have been obvious to the person of ordinary skill at the time of the invention?

GROUPING OF CLAIMS

For each contested ground of rejection and which applies to a group of two or more claims, the Board is requested to select a single claim from the group and to decide the appeal as to the ground of rejection on the basis of that claim alone.

ARGUMENT

In the Final Office Action, Claims 1-8 were rejected as being obvious over various combinations of references. The rejections are unsustainable and should be withdrawn.

Under 35 U.S.C. 103(a), the Examiner carries the initial burden of establishing a *prima facie* case of obviousness. *In re Pianski*, 745 F2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). As part of this, the Examiner must determine whether the differences between the subject matter of the claims and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art."

The rejection must rest on a factual basis with those facts being interpreted without hindsight reconstruction of the invention from the prior art. *See, In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The Federal Circuit has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated and disconnected teachings of the prior art. *See, Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When, as in this case, the Examiner has selected elements of various teachings in making the rejection, the Board ascertains whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case,

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in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. §§ 103, the decision maker must bring judgment to bear.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See, In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

With respect to the rejection of claims 1, 2, 4, 6-7, the Thomson reference is relied on by the Examiner for teaching the basic structure of a pretensioned concrete float unit featuring a foam core encased in concrete. The Gonzalez reference is relied on by the Examiner for teaching protecting foam from water damage. The Shorter reference is relied on by the Examiner as "motivation" for modification of the Thomson structure to include a "protected" core.

The cited Gonzalez reference shows a floatation unit having a concrete channel slab that provides an upper portion of the unit, with a float unit foam float below the slab. The Gonzalez float unit is not of a construction having a foam float or other buoyant core encased in concrete. Rather, as noted at Col. 4, 49-53, the structure is designed to be open to ingress and egress of water.

The Examiner relies on the cited Shorter, Jr reference for teaching that it was known that "cracks may occur in concrete below the waterline." Based solely on this, the Examiner asserts that it would have been obvious to modify the device of Thomson to add the polyethylene coating of Gonzalez around the foam core of the Thomson device. However, as will be noted, Shorter does not attribute any negative to the development of cracks. Rather, Shorter describes that "use of the foam block permits the unit to float even though cracks develop in the concrete below the water line." In addition, the Examiner's reliance on the Shorter, Jr. reference does not establish that one of ordinary skill in the art would view the concrete encased foam structure of Thomson or Shorter, Jr. as requiring any correction or modification. The mere

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fact that the prior art may be modified to reflect features of the claimed invention does not make the modification obvious unless the desirability of such modification is suggested by the prior art. See, In re Fitch, 23 USPQ2d 1780 (Fed. Cir. 1992).

In an attempt to buttress his position, the Examiner asserts that the skilled artisan will recognize that cracks in the concrete will lead to exposure of the encased foam to water, and also that this can lead to exposure to acids and corrosives which can attack the foam. See, Final Office Action at page 4.

This reliance on "common knowledge" as to what a skilled artisan might recognize is improper, and the Examiner cannot simply reach conclusions based on his own assessment of what would be basic knowledge. Rather, the Examiner must point to concrete evidence in the record to support his findings. See, In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), In re Lee, 277 F.3d 1338-1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), and In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). In this case, the only suggestion for providing the claimed combination comes from the Appellant's own disclosure.

It is clear that there must be more than simply itemizing selected elements in the prior art and combining the elements to provide Appellant's invention. As the court stated in Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983), "... virtually all [inventions] are combinations of old elements." Identification of the elements in the prior art is not sufficient, however, to negate patentability, otherwise few patents would ever issue.

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 47 USPQ2d 1453, 1457, 1458 (Fed. Cir. 1998). The "... suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness." In re Rouffet, Ibid. at 1458.

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The rejection of claims 3, 5, and 8 is similarly flawed. In addition, the Examiner has again engaged in "common knowledge" evaluation of the invention. The Examiner relies on the fourth cited patent (Rytand) for disclosing the claimed vent structure. However, Rytand does not disclose any form of a vent for a float unit having a buoyant core encased in concrete with a vent extending into the core to vent gases from the core to the atmosphere. As stated by the Examiner, the Rytand core is "mostly encased" and the Examiner is relying on utility line chases of Rytand to inherently provide the venting structure. The bottom of Rytand is open and there is no need for venting structure. Accordingly, the Examiner has again pieced together components from the prior art using the Appellant's disclosure as a template.

In conclusion, it is submitted that the Examiner has engaged in impermissible hindsight reconstruction of the invention, by selectively choosing portions of the references and combining the portions of the references to provide the claimed invention without motivation from the references themselves to make the specific combination. It is therefore requested that the rejections of Claims 1-8 be reversed and the case passed to allowance.

Respectfully submitted,

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By:

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* * * CERTIFICATE OF FACSIMILE TRANSMISSION***

I hereby certify that this correspondence is being facsimile transmitted to the US Patent Office, Fax No. 703-872-9306, Examiner Andrew D. Wright, Group Art Unit 3617 on the date shown below.

January 18, 2005
Date

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APPENDIX

Claims on Appeal

Claim 1. A corrosion resistant prestressed float system, comprising one or more float units, each including a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

Claim 2. The float system of claim 1, further comprising a plurality of chaseways for receiving post tensioning members for interconnecting a plurality of the units in a desired manner.

Claim 3. The float system of claim 1, further comprising a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

Claim 4. A corrosion resistant prestressed float unit comprising a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

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Claim 5. The float unit of claim 4, further comprising a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.

Claim 6. A floating dock system comprising a plurality of corrosion resistant prestressed float units, wherein the float units each comprise a buoyant core encased within a polymeric coating, concrete encasing the core and polymeric coating, a corrosion resistant mesh to reinforce the concrete, and a plurality of corrosion resistant pretensioned fiber members extending the entire length of the unit.

Claim 7. The dock system of claim 6, further comprising a plurality of chaseways defined within each of the units and a plurality post tensioning members received within the chaseways for interconnecting a plurality of the units in a desired manner to provide the dock system

Claim 8. The dock system of claim 6, wherein one or more of the units includes a vent extending from the core to an exterior surface of the concrete and in communication with the atmosphere for venting gases from the core to the atmosphere.